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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,084	09/21/2000	Keizaburo Sasaki	15689.58	9022

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Adrian J Lee  
WORKMAN NYDEGGER & SEELEY  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, UT 84111

EXAMINER

BLOUNT, STEVEN

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 05/06/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/667,084

**Applicant(s)**

SASAKI ET AL.

**Examiner**

Steven Blount

**Art Unit**

2661

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6 and 10 - 12.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 41 – 56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to these claims, the portion of the specification which supports them is (apparently) located on pages 42, lines 8+, and continuing to approximately the end of the (written portion) specification. This portion of the specification is apparently a translation of a foreign application, and it is so poorly worded that the examiner cannot follow what is being said, and it does not give adequate support for these claims in view of this fact. An example of this may be found on page 42, lines 20+:

“The procedures will be described below. (a) A setting request packet was transmitted from the apparatus 71, passed through the apparatus 72, and disappeared before arrival to node B. The apparatus 71, since a response packet to the setting request packet of (a) is not received for a certain period of time, transmitted again the setting request packet. In this case, only the ID value was set to a value different from the setting request packet of (a). (c) A setting request packet was transmitted from the

apparatus 74, passed through the apparatus 73, and disappeared before arrival to node A. (d) The apparatus 74, to the setting request packet of (b) received through the apparatus 73, since Opt\_C, Opt\_D and Opt\_E cannot be recognized, in a setting rejection packet made a response including these options. (e) The apparatus 73 did not transfer the setting packet of (d) to the apparatus 72, removed Opt\_C, Opt\_D and Opt\_E to produce a setting request packet with changed ID value and transmitted to the apparatus 74".

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 – 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This case is apparently a translation of a foreign application, and is replete with 112 second paragraph problems in the claims. A few examples of these problems are given below.

In claim 1, it would be proper to say that the data conversion apparatus is "for" performing octet deletion so that it can be determined that it is an apparatus claim and not a method claim. Also, it appears that the apparatus itself is octet or bit inserted the way the claim is written. In claim 2, an "additional information addition means" is claimed, yet there is not an "information addition means" which precedes it. Claims 41 – 56 are essentially unintelligible, and must be either completely rewritten or canceled. In claim 56, it should be stated that "as claimed in any one of claims...".

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 17 – 20 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

In each of these claims, only a signal is claimed. This violates the above cited statute.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1, 5, 21, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 5,978,386 to Hamalainen et al.

With respect these claims, Hamalainen et al teaches, in a PPP configuration, removing *stuffing* bytes in col 4 lines 13+ and 19+.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2 – 4, 6 – 20, 22 – 24, and 26 - 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,978,386 to Hamalainen et al.

With regard to claim 2, see the rejection of claim 1 above, and also note the following:

Flag addition means is mentioned in col 7 lines 19+; and see col 6 lines 60 – 66 (flag removal) and col lines 4+ (flag “returned”, ie, (re) insertion);

Information (flag) for identifying a frame partition is mentioned in col 7 lines 14 and 17; and see also col 3 lines 57+ (control fields);

Removing the octets (stuffing bytes) is mentioned above. Note additionally removing the flag, address, control, and check sum fields in col 8 lines 24+, and returning this information as discussed in col 8 lines 35+. Although Hamailainen et al does not *explicitly* say that the flag/control information addition means are “additional”,

as is currently claimed, one of ordinary skill in the art would recognize that they are obvious variations of the additional member that inserts the (octet-inserted) stuffing bytes.

With regard to the following claims (hereinafter referred to as "CI", note the following:

CI 3: see col 3 lines 60+; CI 4: see the above, and note that the additional information is the flag information, since it partitions the frame as discussed above; CI 5: see the above; CI 6: note that the flag information is added and deleted, depending on which end of the transmission path the information is at; C. 7 – 9: see the above; CI 10: it would be obvious to do a flag insert/delete to a not bit/octet, inserted frame. See also col 3 lines 65+; CI 11: see the above; CI 12: see the above, and note the flag is deleted, but it also says that control fields are added/deleted in col 8 lines 35 – 36; CI 13: In Hamalainen et al, you convert to PPP on the receiving end, and it would be obvious to do it to a frame that is not octet inserted or bit inserted. See also col 7 lines 59+; CI 14: see the rejection of claim 13, and the control/flag information added; CI 15: see figure 4D, for example, and note that flag/control information being added is only one possibility; CI 16: see the rejection of claim 15, and the "other control information" discussed above; with regard to claims 22 – 24, and 26 – 36, note that the steps in these method claims are all discussed with respect to the rejection of the apparatus claims above.

11. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,666,362 to Chen et al.

With regard to claim 37, it is noted that Chen et al teach, in col 7 lines 37+, that member 101, cited as a "PPP driver software", is used for "responding to LCP packets".

While this "responding" is not stated to be an "echo reply", the examiner believes that this would be one obvious form of a "response" message and that one of ordinary skill in the art would recognize it as such. Note that the first and second members can be considered to be the DTE 100 and the other DTE it is communicating with, respectively (though not explicitly shown), and that while member 101 is shown within member 101 in figure 3, having it located physically separate from this member is an obvious variation.

12. Claims 37 – 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants Admitted Prior Art (Hereinafter referred to as AAPA) in view of either one of the following patents: 1) U.S. patent 5,978,386 to Hamalainen et al, or 2) U.S. patent 6,438,137 to Turner et al.

With regard to claims 37, AAPA teaches, on page 10 lines 1+ of the specification, the process of a member transmitting a LCP echo request packet "to confirm whether or not LCP link is maintained", and the other member receiving the LCP echo request packet, and then transmitting an echo response packet. AAPA does not, however, teach carrying out this process in a DCE to one of two apparati performing communications.

Carrying out PPP communication is taught in Hamalainen as discussed above. Further, members SN1 and SN2 can be considered to be DCE's which are capable of carrying out the echo request/confirmation process taught in AAPA, and it would be



obvious to one of ordinary skill in the art to do so in order to enable the members in the communication system to realize who their peers are.

Additionally, Turner teaches peers (routers A and B, and their associated "other apparati", (see figure 1) with DCE's (packet translators 14 and 34) which would also benefit from the echo request/response procedure taught in AAPA and discussed above; and it would as such be obvious to one of ordinary skill in the art at the time of the invention to carry out the process taught in AAPA with the system taught in Turner.

With regard to claim 38, see the discard process taught in AAPA, page 6 lines 5+ and, especially, page 7, lines 5 – 10.

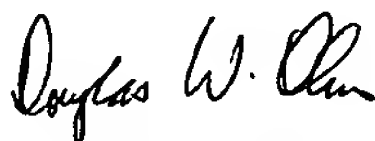
With regard to claims 39 - 40, see the above, and note that, with their protocol conversion capabilities, members A and B in figure 1 of Turner et al can be considered to be "gateways", and that LCP is mentioned in line 2 of column 7; and that in Hamalainen et al, the gateway node mentioned in col 9 lines 37+ (which is also stated to be capable of performing the protocol conversion) would be capable of performing the transmitting/discarding function taught in AAPA.

With regard to claims 41 – 56, note the communication apparati (A, B, SN1, SN2, and the gateway) mentioned above, as well as the following in AAPA: page 6, line 23 (setting request), page 6, line 26 (setting negation), page 7, line 16 (negotiate), page 7, line 21 (response), page 9, line 7 (setting ID), and page 9, line 16 (end ID).

Although these portions of AAPA (in addition to the teachings of Hamalainen and Turner et al) teach the claim limitations recited, it is to be noted that since an apparatus is claimed followed by method steps which do not involve apparatus limitations, they

can be accorded no patentable weight, and as such all that is really claimed in these claims is a "communication apparatus".

13. Examiner Steven Blount may be reached at 703-305-0319 between the hours of 9:00 and 5:30 Monday through Friday.



DOUGLAS OLMS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

SB



4/30/04